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IN THE

Supreme Court of the United States

OCTOBER TERM 1929.

No. 48

AMERICAN FRUIT GROWERS, INC., *Petitioners,*
v.
BROGDEX COMPANY, *Respondent.*

BRIEF OF AMICI CURIAE.

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IN THE

Supreme Court of the United States

OCTOBER TERM 1929.

No. 667.

AMERICAN FRUIT GROWERS, INC., *Petitioners*,
v.
BROGDEX COMPANY, *Respondent*.

BRIEF OF AMICI CURIAE.

INTRODUCTORY STATEMENT.

Counsel appearing herein as amici curiae represent, respectively, the State of Florida, and the Florida Citrus Growers Clearing House Association, the largest association of organizations and shippers engaged in the raising, selling and distribution of citrus fruits in Florida, handling over 80 per cent of the entire citrus crop of Florida.

This brief is submitted in the belief that several significant and important questions of law are involved which require final determination by this court.

The decision of the Circuit Court of Appeals for the Third Circuit in this case is to be found in 35 Fed. (2d) 106 (R. Vol. 1, page 705), and that of the District Court in 21 Fed. (2d) 110.

STATEMENT OF FACTS.

The respondent company filed suit for infringement of United States Letters Patent No. 1,529,461, issued March 10, 1925, to Ernest M. Brogden and Miles L. Trowbridge on an application filed August 15, 1923. The bill charged the petitioner with infringement of process claims and article claims.

The patent in suit relates to the method of preserving fruit, and more particularly to the prevention of decay of such fruit by retarding the development of blue mold. Claim 3 may be considered as typical of the process claims, and reads as follows:

> 3. In the preparation of fresh fruit for market, the process which comprises subjecting fruit to the action of an aqueous solution of borax, the fluidity, strength and temperature of the treating solution, and the duration of the treatment, being such that exposed rind or skin tissues of the fruit are effectively impregnated with borax and rendered resistant to blue mold decay, while at the same time the fruit is not scalded nor is its freshness or edibility otherwise substantially impaired.

The following may be taken as typical of the article claims:

> 26. Fresh citrus fruit of which the rind or skin carries borax in amount that is very small but sufficient to render the fruit resistant to blue mold decay.

The District Court rendered a decree holding that the claims of the patent were valid and that petitioner infringed claims 1 to 7, 9, 14 to 18, and 23 to 26 inclusive (21 Fed. (2d) 110). This decision was affirmed on appeal by the Circuit Court of Appeals for the Third Circuit. Petitioner sought a rehearing, which was denied on November 15, 1929.

NECESSITY FOR GRANTING THE WRIT.

It is submitted that the writ of certiorari sought by petitioner should be granted for the following reasons:

1. This case presents an important question of Federal law which has not been settled by this court.
2. The decisions herein by the Federal District Court and the Circuit Court of Appeals are in conflict with the most nearly applicable decisions of this court.
3. The District Court and the Circuit Court of Appeals rendered their decisions on bases inconsonant with the law as announced in other circuits.
4. The public interest in this controversy is substantial and warrants a determination of the questions involved by this court.

It will be observed that of the reasons above set forth for the granting of the writ, 1, 2 and 3 are included within the reasons which will be considered by this court in exercising its sound judicial discretion, as contained in Subsection b, paragraph 5, Rule 38 of Revised Rules, effective July 1, 1928. In respect of the reason assigned in paragraph 4 we invite attention to the case of *Magnum Import Company v. Coty*, 262 U. S. 159, 163, where it is stated that certiorari is employed "second, to bring up cases involving questions of im-

portance which it is in the public interest to have decided by this court of last resort."

I.

Question of Federal Law Which Should be Settled by this Court.

The lower courts held that the oranges which petitioner sells constitute an infringement of the article claims 23 to 26 inclusive. The oranges here in question can be distinguished from the ordinary orange only after careful chemical analysis (Petition for Certiorari, page 2). They are identical with oranges fresh from the trees save for a minute amount of borax in the rind. An idea of the infinitesimal quantity of borax upon any one orange is obtained when it is shown that a pound of borax is used for twenty-five thousand oranges (Petition for Certiorari, page 3). The question presented for determination by this court is whether such an object is "an article of manufacture," or rather a "manufacture," within the contemplation of patent law. Counsel have been unable to find any case decided by this court in which a definition in the patent sense of the word "manufacture" has been given, nor has any decision of this court been found wherein there has been squarely presented for determination the question of just what is a manufacture, as found in Section 4886 of the Revised Statutes (Section 31, Title 35 U. S. C. A.). Certainly no case approximating the instant situation has been presented for the decision of this court.

It is true that there are decisions in the various Circuits which attempt to define the word "manufacture",

but as will be hereinafter pointed out, such decisions are in conflict.

It is of large moment to the public that it be apprised of the meaning of the word "manufacture" as used in the patent statutes, particularly in view of the diversity of opinions between the lower Federal courts. In the absence of any authoritative definition of the word "manufacture" by this court, it is submitted that the questions raised and product involved in the instant case present an opportunity for laying down a definition for the guidance of the lower courts and the public, and of determining the limits of the statute.

II.

The Lower Federal Courts Have Decided the Present Case in Conflict with the Most Nearly Applicable Decisions of This Court.

Both of the lower Federal courts in their decisions held that an orange treated in accordance with the process of the patent formed a proper subject matter for an article claim. This holding of the lower courts was over the strenuous objection of petitioner, and was evidently predicated on the supposed authority of *Riter-Conley Manufacturing Company v. Aiken et al.*, 203 Fed. 699. That case, which held a building structure to be an article of manufacture within the sense of the patent law, will be discussed presently, and its insufficiency as an authority in the instant case pointed out.

Whilst, as above stated, no decision of this court has been found in which there was presented for determination the question of just what the word "manufacture" in the patent statutes embraces, support for

petitioner's contention that an orange treated with borax is not an article of manufacture is to be found in the decisions of this court. Attention is invited to the case of *Anheuser-Busch Brewing Association v. The United States*, 207 U. S. 556, in which there was presented the question of whether corks which had been subjected to a rather elaborate treatment were "articles of manufacture" under the tariff law. The extent of the treatment to which the raw corks were subjected is evidenced by the fact that the whole process took from one to three days. The contention was made in that case that any change in a natural product rendered that product a "manufacture"—substantially the same contention which the respondent has made herein—and in which the lower courts acquiesced. The answer of this court to that contention made in the *Anheuser-Busch case* was in the following language (p. 562):

> "'Manufacture' implies a change, but every change is not manufacture, and yet every change in an article is the result of treatment, labor, and manipulation."

Again, in the earlier case of *Hartranft v. Wiegmann*, 121 U. S. 609, there was presented the question of whether shells (of Mollusca) which had been subjected to rather extensive treatment were manufactures. This court held that they could not be properly considered a "manufacture". In disposing of the contention that they should be placed in that category the court used the following language (p. 615):

> "They were still shells. They had not been manufactured into a new and different article, having a distinctive name, character or use from that of

> a shell. The application of labor to an article, either by hand or by mechanism, does not make the article necessarily a manufactured article, within the meaning of that term as used in the tariff laws. Washing and scouring wool does not make the resulting wool a manufacture of wool. Cleaning and ginning cotton does not make the resulting cotton a manufacture of cotton."

It is submitted that the decisions by this court in tariff cases are applicable to cases involving patents. This contention is not without authority. The case of *Riter-Conley Manufacturing Company v. Aiken*, 203 Fed. 699, the very case relied upon by the Circuit Court of Appeals in support of its holding herein that the article claims were directed to subject matter embraced within the statute, relies largely upon interpretations of the word "manufacture" by courts in deciding tariff cases. After quoting from only a single patent case and three textbooks, the court in the *Riter-Conley case* attempted to support its definition of the word "manufacture" by quoting from six cases, none of which involved patents, and two of which were cases based upon the tariff act.

By adopting that same procedure in the instant situation, it will be readily seen that the decisions of the lower courts herein are clearly irreconcilable with the decisions of this court in the *Anheuser-Busch* and *Hartranft-Wiegmann cases, supra*, in both of which cases the natural products were subjected to more extensive and elaborate treatment than is accorded the fruit in the instant case.

It is further respectfully submitted that the lower courts rendered opinions that were in conflict with the opinions of this court in so far as the process claims of the Brogden and Trowbridge patents are concerned.

In the trial of this case in the District Court, the defense introduced an abundance of art to show that the use of borax in the preservation of fresh fruits was old and well known as far back as 1874 (Gahn, U. S. patent No. 161,944, October 14, 1874, R. vol. II, page 1005). The antiseptic and preservative quality of boracic acid (which is included in the scope of the process claims herein) was also disclosed in the Bishop U. S. patent No. 683,859, issued on October 8, 1901 (R. vol. II, page 927), which patent was for a process of preserving foods by dipping the food in a boracic acid solution and subsequently coating the food with gelatin. With respect to the action of boracic acid on the food Bishop says (R. vol. II, page 927):

> "The article of food (fruit, vegetables, eggs) to be treated is first washed or bathed in a comparatively weak solution of boracic acid, which destroys any and all germs and thoroughly cleanses and renders the article wholesome."

The Bishop patent was not a theoretical conjecture on the part of the patentee, for as set forth in the testimony of Frank Bishop, the son of the patentee, a company was formed to carry on the process of the patent (R. vol. I, page 214). Mr. Bishop further testified that he personally had treated oranges and pears for the company according to the disclosure of the Bishop patent (R. vol. I, 220-222). This practice of the Bishop invention on a commercial scale occurred during the years 1902 to 1906 and no testimony in contradiction of the Bishop testimony was adduced by the respondent.

Furthermore, it was recognized by both of the courts below that the use of borax and boracic acid as anti-

septics and preservatives was old and well known long prior to the alleged invention of Brogden and Trowbridge. The question is then presented whether the use of an old and well known process for preserving food forms a proper basis for a patent which limits the use of that process to a specific kind of food, namely citrus fruit in the preservation of which it had long been used before. The petitioner, in its brief filed herein in support of the petition for the writ, refers to several of the leading cases of this court on the question. It is desired to refer to but one additional case, that of *Milligan and Higgins Glue Company v. Upton*, 97 U. S. 3. The patent there in suit was for glue rather finely comminuted in order to render it readily permeable by water and to facilitate its solution. It appears from the report that there was no question that the article was new in commerce, the glue previously known and used having been sold in the form of flakes, but this court held the patent invalid for want of invention. We quote from the opinion in that case the following which sheds light both on the question of invention and on the question of the validity of respondent's article claims (pp. 5, 6):

> "The advantages from such division consist in its more ready and rapid solution, its greater convenience for packing and retailing, and its whiter appearance and enhanced palatableness. The whole claim is to an old article of commerce in a state of mechanical division greater than previously used, but unchanged in composition and properties; and the benefits arising from the increased division are such as apparently in every soluble substance when divided into minute particles

* * * * * * * *

"There is nothing new in the fact that the solution of a soluble substance is accelerated by increasing its fragmentary division; nor is there anything new in the fact that articles with rough angles and edges can be more readily put up into packages without injury to their wrappers when reduced by mechanical division into small particles; nor is there anything new in the fact that such articles generally improve in appearance by granulation or powdering.

A distinction must be observed between a new article of commerce and a new article which, as such, is patentable. Any change of form from a previous condition may render the article new in commerce; as powdered sugar is a different article in commerce from loaf sugar and ground coffee is a different article in commerce from coffee in the berry. But to render the article new in the sense of the patent law, it must be more or less efficacious, or possess new properties by a combination with other ingredients; not from a mere change of form produced by a mechanical division."

Again, page 6-7 (Italics added):

"*Where certain properties are known to belong generally to classes of articles, there can be no invention in putting a new species of the class in a condition for the development of its properties similar to that in which other species of the same class have been placed for similar development;* nor can the changed form of the article from its condition in bulk to small particles, by breaking or bruising or slicing or rasping or filing or grinding or sifting, or other similar mechanical means, make it a new article, in the sense of the patent law."

The product of the process of the patent in suit is not a proper article as heretofore pointed out for protection of the patent laws, and, moreover, it is abundantly clear that the article has many times before the filing of the patent been made by others than the patentees. Prior art is replete with processes which inevitably result in this claimed article.

The patentees should not be allowed to obtain protection on the ground of novelty, when the process of making the article and the article itself are both old. All they have done has been to go to the dictionary of biological terms and find that one of the numerous fungus growths inhibited by borax is blue mold. Surely this does not amount to invention.

It is submitted, in view of the prior art, as shown by the evidence, and the decisions relied on by the petitioners herein and the case of *Milligan and Higgins Glue Company v. Upton*, it would clearly appear that there was no invention in using borax or boracic acid in a solution of a strength sufficient to destroy or inhibit the development of blue mold. The testimony is replete with instances of the use of such materials for similar purposes, and it is submitted that any person skilled in the art and confronted with the problem of preventing blue mold decay in oranges or other citrus fruit would, and as a matter of fact did, adopt the process claimed in the Brogden and Trowbridge patent.

It is respectfully insisted this is not a case in which there is doubt as to the presence or absence of invention—the process in controversy, if not squarely met by the prior art, was so proximate thereto as to furnish no doubt as the obviousness of the method of dealing with the problem. Notwithstanding this, both of the lower courts stressed, we submit, to an unwarranted

extent, the commercial adoption of the process disclosed in the patent. It is of course well settled by decisions of this court that the commercial success of an alleged invention is to be considered most circumspectly. *McClain v. Ortmayer et al.*, 141 U. S. 419, *Duer v. Corbin Cabinet Lock Company*, 149 U. S. 216. In the first case, the danger of employing commercial success as the criterion of patentability is set forth in the following language (141 U. S. 428):

> "If the generality of sales were made the test of patentability, it would result that a person by securing a patent upon some trifling variation from previously known methods might, by energy in pushing sales or by superiority in finishing or decorating his goods, drive competitors out of the market and secure a practical monopoly, without in fact having made the slightest contribution of value to the useful arts. The very case under consideration is not barren of testimony and the great success of the McClain pads and clasping hooks, a large demand for which seems to have arisen and increased year by year, is due, partly at least, to the fact that he was the only one who made the manufacture of sweat pads a specialty, that he made them of a superior quality, advertised them in the most extensive and attractive manner, and adopted means of pushing them upon the market, and thereby largely increased the extent of their sales."

Here again, then, in connection with the questions of commercial success of the process, it is submitted the District Court and the Circuit Court of Appeals have clearly gone contrary to the decisions of this court.

III.

The Lower Courts' Decisions Are Based On Propositions of Law Contrary To Holdings In Other Circuits.

There are certain doctrines enunciated in the decisions of the lower courts in the instant case which are directly contrary to the law prevailing in other circuits. This applies to the holding of the lower courts herein with respect to both the article claims and the process claims.

As shown in the preceding point, the Circuit Court of Appeals, in holding that the article claims were directed to patentable subject matter, cited the case of *Riter-Conley Manufacturing Company* v. *Aiken*, 203 Fed. 699. That case held that a roof structure was a "manufacture" and apparently rested upon the definition given by Judge Acheson in the case of *Johnson* v. *Johnston*, 60 Fed. 618, wherein it was held that the word "manufacture" in the patent law "has a very comprehensive sense, embracing whatever is made by the art or industry of man, not being a machine, a composition of matter, or a design." It is submitted that this definition of the word "manufacture" is far too inclusive. Reference to a few cases will suffice to show the error of that definition.

In the case of *Armstrong Seatag Corporation* v. *Smith's Island Oyster Company*, 254 Fed. 821, there was before the Circuit Court of Appeals for the Fourth Circuit a suit for infringement of a patent for an oyster having affixed to it a tag as a mark of identification. Here was something that was "made by the art or industry of man" and was confessedly neither a machine, a composition of matter, nor a design.

The court, however, had no hesitancy in holding that a tagged oyster was not proper subject matter for a patent because it did not fall within any of the statutory classes. The court said: (p. 822)

> "If the patent in suit be supposed to cover a tagged oyster, the answer is that a tagged oyster is not a machine or a composition of matter, and it is not a manufacture. A spring chicken, with an identifying tag fastened to its leg, is closely analogous. If he so desired, any fisherman could attach an identifying tag to his fish. But none of these natural products could be classed as manufactured articles, simply because of being tagged."

Similarly, note the case of *Knight* v. *Reiger, et al.*, 203 Fed. 49, decided by the District Court for the District of Maryland (affirmed 212 Fed. 935) wherein it was stated (p. 52):

> "The learned author of Walker on Patents (4th Ed.) p. 13, contends that the word 'manufacture' as used in the patent law should be given a construction broad enough to cover everything made by the hands of man and not a machine or a composition of matter. The weight of the decided cases is to the contrary. *Jacobs* v. *Baker*, 7 Wall. 295; *Fond du Lac County* v. *May*, 137 U. S. 395; *American Disappearing Bed Co.* v. *Arnaelsteen*, 182 Fed. 324; *International Mausoleum Co.* v. *Sievert*, 197 Fed. 936."

It is apparently well recognized now that there are certain products which are the result of manipulation or the handiwork of man which are not susceptible of patent protection, quite apart from the question of

novelty or inventive skill. For instance, sculpture is not the subject matter of a mechanical patent, yet into the fashioning of marbles and bronzes there is poured some of man's highest genius. Again, new trees, plants, and shrubbery, which are the results of cross breeding and grafting, are not susceptible of patent protection. As a matter of fact, Congress is now considering the advisability of enlarging the statutory classes provided in Section 4886 of the Revised Statutes (Section 31, Title 35; U. S. C. A.), in order to include just such new breeds or varieties of vegetable life.

Respondent would hardly urge that oranges still growing upon the tree but which have been sprayed with borax are subject matter for patent protection; nevertheless, the holdings of the lower courts afford a basis for urging that growing oranges so sprayed would constitute an infringement of the article claims in suit.

But quite aside from the definition of "manufacture" as given in the *Riter-Conley case*, the decision in that case is directly contrary to decisions in the other circuits. As heretofore pointed out, this court has decided in at least two instances (*Anheuser-Busch* v. *The United States* and *Hartranft* v. *Wiegmann, supra*) that articles markedly analogous to the treated oranges in the instant case are not "manufactures". In the Circuits, there have also been cases equally analogous. For instance, in the case of *Myers & Company* v. *United States*, 147 Fed. 204, the Circuit Court of Appeals for the Second Circuit held that lumber which has been subjected to a fire-proofing process whereby its value is largely increased is not dutiable as manufactures from wood. Again, in the case

of *Kreshower* v. *U. S.*, 152 Fed. 485, before the Circuit Court for the Southern District of New York, it was held that leaves which had been subjected to a process including the application of glycerin and varnish in order to prevent decomposition, were not manufactures, for the reason that (p. 486):

> "The treatment did not result in a change of the leaves from their former appearance. There was no advance in manufacture in the sense that the process of preservation destroyed the original articles or made them useful for other purposes or altered their trade designation. Hartranft v. Wiegmann, 121 U. S. 609."

Thus it has been shown that the mere fact that natural products have been subjected to processes to insure their preservation does not remove those articles from the category of natural products into the category of manufactures, even when such treatments are more extensive and elaborate than in the instant case. Further, as has been shown, the *Riter-Conley case*, on which the decision of the Circuit Court of Appeals rested in regard to the article claims in suit, cannot be distinguished from the cases just referred to on the ground that those cases involved the question of tariff, while the *Riter-Conley case* involved a patent. The *Riter-Conley case*, it will be recalled, cited only one patent case, whereas some six cases involving tariff, bankruptcy and general law were cited and quoted in support of the court's holding.

The above suffices to show that the decisions of the lower courts in the instant case with respect of the validity of the article claims were contrary to the law as laid down by the courts in other Circuits, because outside the scope of the word "manufacture."

With respect of the process claims, it is clear the District Court and the Circuit Court of Appeals in the instant case applied doctrines contrary to those laid down in other Circuits, because of lack of invention in the subject matter covered by these process claims. As shown, both courts found borax and boric acid had been used to prevent the growth of mold or fungi upon foods, long prior to the entrance of the present patentees into the field—hence the combination of borax and citrus fruits is admittedly old. It was also found that these preservatives were used both in a dry state and in solution, and that the solutions were both hot and cold. The most favorable view, then, for the respondent was that, notwithstanding this prior art, borax or boracic acid had not been used as an inhibiting agent for controlling blue mold decay on fresh citrus fruit. This is merely a question of new and analogous use, and as laid down in numerous decisions, such a new use is not susceptible of patent protection. As was said by Judge Sanborn of the Circuit Court of Appeals of the Eighth Circuit in the case of *Warren Webster & Company* v. *Dunham Company*, 181 Fed. 836, 839:

> But the thought that an existing machine or combination, discovered in the same art or one nearly analogous to it, designed and suitable to perform a similar function, may be used or adopted to accomplish the desideratum, is not the product of inventive genius, but the result of the application of the skill of the mechanic to the subject under consideration. It is only when the new use is so recondite and remote from that to which the old device and combination has been applied, or for which it was conceived, that its application would not occur to the mind of the

ordinary mechanic skilled in the art, seeking to devise means to perform the desired function, with the old machine or combination before him, that its conception may rise to the dignity of invention."

Numerous other cases might be quoted from in support of the principle of the *Webster case*. For example, in *Locklin v. Buck*, 159 Fed. 434, the Circuit Court of Appeals for the Second Circuit held that even though the manufacture of window screens was quite a different and distinct industry from the manufacture of mattresses, nevertheless there was no invention in using certain woven wire fabric in the making of a bed bottom when such material had previously been used in the manufacture of screens.

Again, in the case of *Electric Boot and Shoe Finishing Company v. Little*, 138 Fed. 732, the Circuit Court of Appeals for the First Circuit held that, inasmuch as anilin black had been in general use for dyeing all kinds of materials, there could be no invention in using anilin black for the purpose of dyeing shoes.

The Circuit Court of Appeals for the Eighth Circuit, in the case of *Baker v. Duncombe Manufacturing Company*, 146 Fed. 744, held that a patent covering the roasting and grinding of coffee and subjecting the ground product to a blast of air for the purpose of separating the dust and chaff from the coffee granules, was void for want of invention in view of the age-old practice of using a draft of air to separate wheat from its chaff, and that even the combination of the preliminary step of roasting the coffee would not raise the process to the dignity of invention, inasmuch as this step was an old and well known method of treating coffee.

If respondent contends that the specific process and exact amounts were never employed heretofore, the decision in *Continental Fibre Co. v. Formica Insulation Co.*, 287 Fed. 455, affords a complete answer. There the Circuit Court of Appeals for the Sixth Circuit had before it the patent which was supposed to constitute an improvement over the bakelite patent in that the material of the improvement was saturated, whereas the bakelite patent related only to a surface permeation. In disposing of the contention that this was a patentable difference the court stated (p. 456)

> "We are not able to think that the difference between a surface permeation and saturation, and a saturation which goes to the center of the sheet is in itself anything more than a difference in degree, depending upon the existing physical conditions, and the advantage of getting as much saturation as possible we think must have been obvious to every one."

The lower courts in the instant case also departed from the well-settled rule that the commercial success of an alleged invention and the fact that others were seeking a solution, can be availed of only in cases where the presence of invention is doubtful, and can never be employed to raise a doubt where lack of invention is clear (*Rod & Burnham Company v. Payne*, 190 Fed. 172; and *Slipcoat Company v. Evlene's*, 289 Fed. 641). The contention which was made by the respondent was urged before the Circuit Court of Appeals of the Eighth Circuit in *Webster Company v. Dunham*, *supra*, and was disposed of by the court in the following language: (181 Fed. 836, 839)

[illegible]